

**REMARKS**

This Amendment is filed in response to the non-final Office Action dated May 23, 2007, and is respectfully submitted to be fully responsive to the rejections raised therein. Accordingly, favorable reconsideration on the merits and allowance is respectfully submitted to be proper.

The amendments and how they respond to the rejections set forth in the Office Action is explained below in detail.

In the present Amendment, the Specification has been amended to correct a typographical error.

Claims 1 and 10 have been amended by deleting the phrase “a solvate thereof, or a prodrug thereof”.

Claim 1 has been further amended to recite that ring J is selected from the group consisting of dihydrobenzooxazin-2-yl, benzodioxan-2-yl, dihydrobenzofuran-2-yl, dihydrobenzofuran-3-yl and benzodioxol-2-yl.

Claims 2 and 3 have been canceled.

Claims 16 and 17 were previously canceled.

Claims 4 and 8 have been amended to depend from claim 1.

No new matter has been added. Support for the amendment to claim 1 can be found throughout the specification on pages 66-73 wherein Examples 13(1) - 13(31) are enumerated, for example.

Entry of the Amendment is respectfully submitted to be proper. Upon entry of the Amendment, claims 1, 4-15 and 18 will be all the claims pending in the application.

**I. Election/Restriction**

Applicants affirm the provisional election of Group I, claims 1-9. The election was made without traverse. Applicants reserve the right to file a Divisional Application directed to the non-elected claims.

**II. Response to Rejection of Under 35 U.S.C. § 112**

Claims 1-9 were rejected under 35 U.S.C. § 112, first paragraph as allegedly lacking enablement for the terms “solvate” and “prodrugs”.

Without acquiescing, Applicants have amended claims 1 and 10 to delete the terms “solvate” and “prodrugs” to advance prosecution. Withdrawal of the rejection is respectfully requested.

Referring to page 9 of the Office Action, Claims 1-8 were rejected under 35 U.S.C. § 112, first paragraph as allegedly lacking enablement with respect to using the compounds of Formula (I), wherein W is a ring other than a phenyl ring and wherein J is other than a benzoxazin-2-yl, benzofuran-yl or benzodioxol-2-yl ring. The Examiner admitted, however, that the Specification is enabling for those compounds, wherein variable W of Formula (I) represents a phenyl group and wherein J represents a benzoxazin-2-yl, benzofuran-yl or benzodioxol-2-yl ring. The Examiner further asserted that the working examples provided in the present Specification are drawn to compound wherein ring W is a non-basic benzene ring. The Examiner stated that pyridine and pyrazine rings are basic. Further, they are hydrogen bond acceptors and  $\Pi$ -electron deficient.

In response to the rejection, Applicants submit a Declaration under 37 C.F.R. § 1.132. The 132 Declaration is being submitted herewith to provide experimental data as probative

evidence that the compounds of Formula (I) containing a basic ring (i.e. pyridine) also has DP receptor antagonist activity.

Applicants respectfully request consideration of the experimental data contained in the 132 Declaration. In light of the evidence, withdrawal of the rejection is respectfully requested.

### **III. Response to Rejection Under 35 U.S.C. § 102(a)**

Claim(s) 1-8 are rejected under 35 U.S.C. 102(a) as allegedly being anticipated by WO 03/078409 to Ohie *et. al.* (“Ohie ‘409”).

With regard to the compounds represented by the Formula (I), when R<sup>12</sup> and R<sup>13</sup> each simultaneously represent a hydrogen atom, the compound represented by Formula (I) represents a compound selected from the group consisting of the compounds (1) to (32). In light of the amendment to claim 1, which further limits the variable J, the subject matter of claim 1 does not read on Ohie ‘409. Withdrawal of the rejection is respectfully requested.

### **IV. Response to Provisional Obviousness-Type Double Patenting Rejection**

#### **A. Co-pending Application No. 10/544,646**

Applicants respectfully traverse the provisional obviousness-type double patenting rejection based on co-pending Application No. 10/544,646 (“the ‘646 application”).

The compound of the present invention represented by Formula (I) is a 1,3-substituted benzene derivative. On the contrary, the compounds of '646 application represented by formula (I) is a 1,2-substituted benzene derivative and is clearly different from that of the present invention in terms of their structures. Furthermore, the present invention is directed to a compound having a DP receptor antagonistic activity, while the ‘646 application is directed to a

compound having EP3 receptor antagonistic activity. Therefore, Applicants submit that the present claims are not obvious variants of the subject matter claimed in the '646 application.

Withdrawal of the rejection is respectfully requested.

**B. Co-pending Application No. 10/507,885**

With respect to the provisional obviousness-type double patenting rejection based on co-pending Application No. 10/507,885, Applicants concurrently submit herewith a Terminal Disclaimer. In consideration of the Terminal Disclaimer, withdrawal of the rejection is respectfully requested.

**V. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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Date: November 23, 2007